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PATENTS
UV-179

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicant : Johnny B. Corvin
Application No. : 09/775,115 Confirmation No. : 8786
Filed : February 1, 2001
For : METHODS AND SYSTEMS FOR FORCED
ADVERTISING
Art Unit : 2623
Examiner : Justin E. Shepard

New York, NY 10020
January 4, 2007

Mail Stop AF
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Pursuant to 1296 Off. Gaz. 2 (July 12, 2005), applicant requests review of the final rejection of claims 14-16 and 40-48 in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal.

Arguments begin on page 2 of this paper.

ARGUMENTS

I. Summary of Office Action

Claims 14-16 and 40-48 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond et al. U.S. Patent No. 6,698,020 (hereinafter "Zigmond"), in view of Nagasaka et al. U.S. Patent No. 5,818,439 (hereinafter "Nagasaka"), and in further view of Dunn et al. U.S. Patent No. 5,721,829 (hereinafter "Dunn").

II. Summary of Arguments

For the purposes of this Request, applicant will specify the omission of essential elements required to make a *prima facie* rejection of claims under 35 U.S.C. § 103(a) in the October 5, 2006 final Office Action (hereinafter "Office Action"). In particular, applicant will show that there is no motivation to combine the references used to reject independent claims 14, 40, 43, and 46 under 35 U.S.C. § 103(a) and that the alleged combination does not show each claimed feature. Applicant reserves the right to present additional arguments upon the decision of the panel review.

III. There is No Motivation to Combine the References

Applicant's independent claims 14, 40, 43, and 46 are directed toward a method, systems, and machine-readable medium for presenting a forced advertisement on user equipment. The forced advertisement is detected in an incoming video stream and presented on the user equipment. The user equipment is turned off while the forced advertisement is being presented. The forced advertisement is automatically presented, when the user equipment is turned on, from the beginning of the forced advertisement or recommenced from the point at which the user equipment was turned off.

Zigmond relates to selecting and inserting advertisements into a video programming feed. To address advertisement avoidance by "aggressive channel surfers," Zigmond inserts a particular advertisement into each advertisement slot that a channel surfer encounters, or alternatively, simultaneously broadcasts a selected advertisement on all channels. See Zigmond, column 13, ll. 16-39.

Nagasaka relates to a video playback system. When a video program is interrupted by a user by turning off the set top box on which it is playing, the user is given the

option to choose whether to continue playing the video program the next time the set top box is turned on. See Nagasaka, column 14, ll. 21-26.

Dunn relates to a system for automatically pausing and resuming video-on-demand (VOD) content when the viewer switches from the VOD channel on which the content is being presented to a non-VOD channel prior to completion to the ordered VOD content and then back to the VOD channel. See Dunn, column 2, ll. 11-18.

The Office Action acknowledges the novelty (in view of Zigmond and Nagasaka) of applicant's claimed feature of "automatically present[ing] [the forced advertisement] after the user equipment is turned back on" (see Office Action, page 4, ll. 3-4). To make up for this acknowledged deficiency, the Office Action relies on a motivation argument to modify an alleged combination of Zigmond, Nagasaka, and Dunn.

In this motivation argument, the Office Action states that:

"Dunn discloses a system where the advertisement is automatically presented after the user equipment is turned back on (column 2, ll. 11-18) ... it would have been obvious to add the automatic resuming taught by Dunn to the system disclosed by Zigmond and Nagasaka. The motivation would have been to force the user to watch the commercial or program after the power turned back on."

(Office Action, page 4, ll. 5-10). The basis relied upon, as set forth in the Office Action, for modifying the alleged combination fails to support such a modification for several reasons. First, the Office Action erroneously contends that Dunn discloses a system for automatically resuming video content when the system on which it was being presented is turned off and then on. The portion of Dunn cited by the Office Action (column 2, ll. 11-18) fails to provide support for this contention. As described above, this section of Dunn relates merely to resuming VOD content when a user returns to a VOD channel after switching from the VOD channel while VOD content is being presented. It is silent as to how/if Dunn reacts when the system is turned off while the VOD content is being presented. Furthermore, applicant is unable to find support for this purported feature anywhere in Dunn. By ignoring this deficiency and using Dunn as a basis for modifying Zigmond and Nagasaka, the Office Action arbitrarily presumes that automatically resuming content after changing a channel and automatically resuming content after a system is turned off and on are interchangeable. They are not. The basis is therefore improper because the Office Action impermissibly likens two obviously different features, thereby giving the Examiner unfettered discretion in rejecting any invention.

Second, Nagasaka requires a user to affirmatively select to resume interrupted video content before the content is displayed. Manual viewer choice to resume or abort video content clearly contradicts with the cited discussion in Zigmond of "eliminating 'aggressive channel surfers'" (see Office Action, page 3, ll. 10-12). Specifically, if so-called aggressive channel surfers were given the option to resume or abort an advertisement that they, as defined by Zigmond, did not want to view in the first place, it would defeat the notion of forcing them to view the advertisement.

Furthermore, even if Zigmond could be modified in view of Nagasaka, which it could not, one skilled in the art would not be motivated to look to Dunn to "force the user to watch the commercial or program after the power is turned back on," (as stated by the Office Action as the motivation for making the proposed modification) because such a motivation would eviscerate the spirit of both Nagasaka's video playback system (a system that is aimed at helping the viewer remember the contents of past viewing) and Dunn's system for automatic pause/resume (a system aimed at affording the viewer flexibility in viewing rented programs). In the alleged combination suggested by the Examiner, Zigmond and Dunn would contradict on what would happen if, for example, a viewer switched from a non-VOD channel displaying a forced advertisement to a VOD channel displaying ordered VOD content. In this instance, Dunn teaches that the viewer be presented with the VOD content whereas Zigmond would teach that the viewer be presented with the forced advertisement from the previous channel. The Examiner provides no basis to suggest that one option overrules the other. In fact, it is clear that the Examiner has no legitimate basis for combining these references. With the knowledge of applicants' novel systems and methods for presenting forced advertisement, the Examiner identified and isolated particular features of Nagasaka and Dunn for use in combination with Zigmond to reject applicant's invention, without providing the requisite evidence for combining these references. In doing so, the Examiner has simply taken applicants' disclosure as a blueprint for piecing together these references, thereby demonstrating mere hindsight reconstruction, which is the very syndrome that the requirement for objective evidence is designed to combat. See *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999).

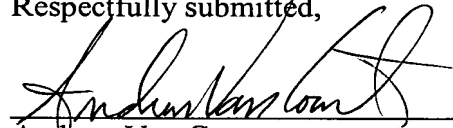
IV. The Combination of the References Does Not Show Each Claimed Limitation

Applicant submits that even if all three references could be combined, which they could not, the combination fails to show or suggest each limitation of independent claims 14, 40, 43, and 46 at least because both Nagasaka and Dunn fail to teach or suggest automatically presenting the forced advertisement, when the user equipment is turned on, from the beginning of the forced advertisement or recommencing the forced advertisement from the point at which the user equipment was a turned off , as specified in applicant's claims.

V. Conclusion

For at least the above reason, applicant submits that requirements for establishing a *prima facie* case of obviousness have not been met to support the rejection of independent claims 14, 40, 43, and 46 under 35 U.S.C. § 103(a). Accordingly, the Examiner's rejection under 35 U.S.C. § 103(a) is insufficient as a matter of law. Applicant also submits that dependent claims 15, 16, 41, 42, 44, 45, 47, and 48 are also not obvious for at least the same reason. Accordingly, applicant respectfully requests that the panel issue a written decision withdrawing the rejection of the claims under 35 U.S.C. § 103(a).

Respectfully submitted,



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